

Serial No 09/483,062

In reply to Office Action mailed May 4, 2004

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### REMARKS/ARGUMENTS

Claims 1-18 are pending in this application. Claims 1-12 have been deemed allowable, and claims 13-18 have been rejected. Claims 13 and 14 are currently amended, and these amendments are fully supported by the specification. For at least the reasons stated below, Applicant asserts that all claims are in condition for allowance.

As an initial matter, Applicant notes that independent claims 1, 7, and 13 are largely parallel insofar as they contain similar claim limitations except that claim 1 is directed towards a method, claim 7 is directed towards a computer program embodied on a computer readable medium, and claim 13 is directed towards a system. Additionally, the previous Amendment and Response to Office Action, dated April 21, 2004, amended independent claims 1 and 7 in nearly identical fashion. However, Applicant inadvertently failed to amend claim 13.

In the present Amendment, Applicant amends claim 13 in substantially the same manner as claims 1 and 7 were previously amended. Moreover, because claims 1, 7, and the dependent claims thereto were deemed allowable over the prior art, Applicant asserts that claim 13 is now allowable as well. The amendment to claim 13 also addresses the 35 U.S.C. § 112 rejections to claims 14, 15, and 18 for lacking antecedent basis.

### CLAIM REJECTIONS UNDER 35 U.S.C. § 112, ¶ 2

Claims 14, 15, and 18 are have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Examiner asserts that the following terms lack antecedent basis: "the application service provider," "the predefined rules," and the upgrades." Claim 13, as amended, provides an antecedent basis for each of these terms.

Examiner further asserts that the phrase, "an of the application service provider ability" in claim 14, is not clearly understood. This phrase has been amended to read, "an ability of the application service provider," which is clearly understood and is the identical language implemented in allowed claims 2 and 8.

Accordingly, Applicant respectfully requests that the § 112 rejections be removed.

### CLAIM REJECTIONS UNDER 35 U.S.C. § 103

Claims 13-18 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Cheng et al. (U.S. Patent No. 6,151,643) in view of Cooper et al. (U.S. Patent No. 5, 809,282). The cited

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references, each alone or in combination, do not teach or suggest all the limitations of the claims as amended as required by MPEP § 2143. Therefore, Applicant respectfully requests that Examiner withdraw the § 103 rejection.

Specifically, claims 13-18 require, *inter alia*, (1) translating an application infrastructure aspect into a common structure and analyzing the common structure, and (2) identifying upgrades to an application infrastructure of an application service provider. As described in more detail in the Amendment and Response to Office Action, dated April 21, 2004, the cited references do not teach or suggest these limitations. However, as Examiner noted in the Office Action mailed May 5, 2004, these limitations were not previously recited in claims 13-18.

In the present Amendment, these limitations have been added to claim 13 in substantially the same manner as they were previously added to claims 1 and 7. In the same way that these limitations overcame the cited references for claims 1-12, Applicant respectfully asserts that claims 13-18 are now allowable as well.

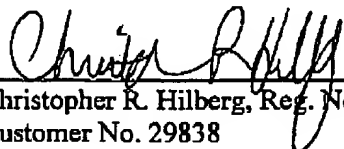
For at least these reasons, Applicant respectfully requests that Examiner's § 103 rejections be withdrawn.

### CONCLUSION

Applicant submits that all pending claims are allowable and respectfully requests that a Notice of Allowance be issued in this case. In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (612) 607-7386. If any fees are due in connection with the filing of this paper, then the Commissioner is authorized to charge such fees including fees for any extension of time, to Deposit Account No. 50-1901 (Reference 60021-341801).

Respectfully submitted,

By

  
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